

### **REMARKS/ARGUMENTS**

Claims 1-20, 22-30 and 33-35 are pending in this application. Claims 24 and 25 have been allowed. Claims 21, 31-32 and 36-37 have been cancelled. In view of the following remarks, Applicant respectfully requests reconsideration of the application.

**I. Rejection Under 35 U.S.C. § 103(a)**

**a. Claims 1-5, 7-9, 11, 16-20, and 22**

Claims 1-5, 7-9, 11, 16-20, and 22 were rejected under § 103(a) as being unpatentable over U.S. Pat. No. Des. 314,471 to Lueth ("Lueth") in view of U.S. Pat. No. 3,053,424 to Reinhard ("Reinhard"). The Examiner states that, while Lueth does not disclose a front member connected to a rear member by way of a spindle and being adjustable to accommodate a varying number of blades, it would be obvious to provide the case of Lueth with a front member arrangement as disclosed by Reinhard. Furthermore, the Examiner states that it would be obvious to include the crossbar arrangement disclosed in Lueth on the front member disclosed by Reinhard in order to maintain the aesthetic qualities of the case. Applicant respectfully traverses.

Contrary to the Examiner's position, there is no suggestion to combine these references. The Examiner claims that the suggestion to combine can be found in Reinhard at Column 1, lines 8-34. This section of Reinhard does not contain any suggestion to combine the references. It is simply a description of

the advantages the apparatus claimed in Reinhard has over the prior art. As described below, in order to apply the teachings of Reinhard to the saw blade holder of Lueth, it would be necessary to completely eliminate nearly every feature of the front and rear plates of Reinhard that provides an advantage over the prior art.

While the Examiner noted in his comments regarding Applicant's arguments in Amendment B that it is Lueth being modified by Reinhard, not the other way around, it would still not be obvious to combine these references, nor does either reference contain a suggestion to do so. First, Lueth discloses a simple, *ornamental* saw blade holder having only one side. There is absolutely no reason one skilled in the art would modify the ornamental design of Lueth by providing a second side. The only reason a second side would be necessary would be to provide a function such as protecting the blades. Since Lueth discloses only features which are strictly ornamental (the definition of a design patent), there would be no reason to modify such a disclosure by providing new features that perform a specific function.

Second, there is no suggestion in Reinhard to make this type of combination. The plates of Reinhard have a very specific construction. See Column 2, lines 26-40. This specialized construction includes solid plates that have a raised center portion that contacts the saw blades when the plates are in use. See column 3, lines 1-19. This allows the plates of Reinhard to abut the

saw blades at the raised central portion, preventing the saw blades from shifting. In order to combine Reinhard with Lueth, the Examiner admits that the plates shown in Reinhard would have to be modified to look like the back member shown in Lueth. This would go against all the teachings of Reinhard, since the plates of Reinhard are constructed specifically to provide advantages over the prior art such as protection of the blades. Restricting the movement of the blades is one way that this protective function is accomplished.

Therefore, since there is no suggestion to combine Lueth with Reinhard, the 103(a) rejection should be withdrawn. Furthermore, as claims 2-5, 7-9, 11, 16-20, 22 all depend from allowable claim 1, the rejection of these claims should also be withdrawn. Applicant again notes that the Examiner stated that claim 10 would be allowable if it was rewritten in independent form including all the limitations of the base claim and any intervening claims, in light of the fact that claim 10 is dependent on allowable claim 1, Applicant submits that claim 10 should also be allowable without amendment.

**b. Claims 26-30 and 33**

Regarding claim 26, in addition to the arguments made with respect to the aforementioned claims, the Examiner also states that the frame of Lueth is constructed of "wire-like" members and therefore meets the definition of a wire frame. Applicant respectfully traverses.

First, as previously argued, there is no suggestion to combine Lueth and Reinhard. For that reason alone, the rejection of claim 26 should be withdrawn. Furthermore, the Examiner is mistaken when he equates the "I-beam" shaped frame disclosed in Lueth with a "wire-like" member. There is nothing that suggests that the very specific construction of the frame disclosed in Lueth is "wire-like" in any way, shape or form. The Examiner does not give an explanation of why the frame in Lueth would be considered "wire-like." While the Examiner is correct that "wire frame" as claimed, does not require the frame to be made of wires, the frame must at least be considered to be "wire-like," and The Examiner fails to point out what is "wire-like" about the frame of Lueth. A "wire-like" frame would be one that had a more planar orientation, similar to the frame shown in the present application. The frame is "wire-like" because the pieces making up the frame have a "wire-like" shape. As shown in Figure 2, this shape can be cylindrical. As shown in Figure 8, this shape can be square. By these arguments, the Applicant is not limiting the claimed invention to only cylindrical or square-shaped pieces to make up the wire frame, but only illustrating the difference between an "I-beam" structure, as shown in Lueth, and a wire structure as shown and claimed in the present application.

Therefore, even if Lueth was inappropriately combined with Reinhard, the combination would not show each and every feature claimed in claim 26, and therefore, the rejection of claim 26 should be withdrawn. Additionally, it would

not be obvious to modify the frame of Lueth to construct it from members that have an entirely different shape. Furthermore, as claims 27-30 and 33 all depend from allowable claim 26, the rejection of these claims should also be withdrawn.

**c. Claims 34-35**

As to claims 34-35, the same argument applies. There is no suggestion to combine Lueth with Reinhard, so the fact that this inappropriate combination would disclose dividers as well is moot. Additionally, the Examiner is incorrect in saying that the frame member of Lueth is "generally flat." The frame member of Lueth has upstanding sides connected to a middle portion, thus forming an "I-beam" shape. Therefore, the rejection of claim 34 should be withdrawn, as well as the rejection of claim 35, which is dependent on allowable claim 34.

**d. Claims 6 and 23**

The Examiner has rejected claims 6 and 23 as being unpatentable as applied to Lueth combined with Reinhard, and further in view of U.S. Pat. No. 2,636,641 to Weipert ("Weipert"). While Weipert may disclose a folding handle, Applicant maintains that it is inappropriate to combine Lueth with Reinhard, and the addition of Weipert does not supply any additional motivation or suggestion to combine. As claims 6 and 23 depend from claim 1, which is allowable over the cited art since there is no suggestion to combine Lueth with Reinhard, they are also allowable.

**e. Claims 12-15**

The Examiner has rejected claims 12-15 as being unpatentable as applied to Lueth combined with Reinhard, and further in view of U.S. Pat. No. 4,955,471 to Hirose ("Hirose"). While Hirose may disclose various outer coverings, Applicant maintains that it is inappropriate to combine Lueth with Reinhard, and the addition of Hirose does not supply any additional motivation or suggestion to combine. As claims 12-15 depend from claim 1, which is allowable over the cited art since there is no suggestion to combine Lueth with Reinhard, they are also allowable.

**III. Allowed Claims**

Applicant notes with appreciation that claims 24 and 25 have been allowed.

**IV. Conclusion**

In conclusion, Applicant has overcome each of the rejections. The application is therefore in condition for allowance. If, for any reason, the Examiner believes that the amendments and remarks do not put the claims in condition for allowance, the undersigned attorney can be reached at (312) 245-5394 to resolve any remaining issues.

Appl. No. 09/924,667  
Amdt. dated March 1, 2004  
Reply to Office action of December 29, 2003

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin B. Rand", is written over a horizontal line.

Justin B. Rand  
Registration No. 48,552

Attorney for Applicant

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200